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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,029	06/20/2003	Gary Schneider	40116/03701	6358
83694	7590	01/22/2009		EXAMINER
Fay Kaplun & Marcin, LLP/ Motorola 150 Broadway Suite 702 New York, NY 10038				REZA, MOHAMMAD W
			ART UNIT	PAPER NUMBER
			2436	
				MAIL DATE
				DELIVERY MODE
			01/22/2009	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/600,029

Filing Date: June 20, 2003

Appellant(s): SCHNEIDER ET AL.

Oleg F. Kaplun
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/30/2008 appealing from the Office action
mailed 09/25/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

This appeal involves claims 1-50.

(4) Status of Amendments

The appellant's statement of the status of amendments rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A copy of the appealed claims 1-46 appears on pages in the Appendix to the appellant's brief is correct.

(8) Evidence Relied Upon

200030172283 Sean M. O'Hara
5534857 Laing et al

(9) Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hara (US patent publication 20030172283) in view of Laing et al hereafter Laing (US Patent 5534857).

9. As per claim 1, O'Hara discloses a method comprising the steps of: sending an initial signal by the first device to establish a wireless communication with the second device, the first device including only a data capturing arrangement ("DCA") as an input device interface with a user thereof (paragraph, 0010-0012, 0024); initiating an authentication process by the second device; obtaining a PIN code from the user via the DCA, the PIN Code identifying at least one device with which the first device is authorized to communicate (paragraphs, 0010-0012, 0021); performing a pairing process to compare the PIN code to entries in a database of authorized PIN codes

(paragraphs 0010, 0019). He does not expressly disclose generating a link key to establish the authenticated communication between the first and second devices. However, in the same field of endeavor, Laing discloses generating a link key to establish the authenticated communication between the first and second devices (abstract, col. 1, lines 50-67).

Accordingly, it would have been obvious to one of ordinary skill in the network security art at the time of invention to have incorporated Laing's teachings of establishing a link key with the teachings of O'Hara, for the purpose of suitably using the authenticated communication between these two devices (abstract, col. 1, lines 50-67).

10. As per claim 2, O'Hara discloses the method wherein the databases is stored in a memory arrangement of the second device (paragraphs 0010, 0019).

11. As per claim 3, O'Hara discloses the method wherein the first device is a mobile barcode scanner (abstract, paragraph 0030).

12. As per claim 4, O'Hara discloses the method wherein the first device communicates with the second device using Bluetooth technology (paragraphs, 0029-0030).

13. As per claim 5, O'Hara discloses the method wherein the obtaining step further includes the following substeps: scanning a barcode using the DCA, the barcode being provided by the user as the PIN code, and converting the barcode into the PIN code using a processor of the first device (paragraphs, 0010-0012, 0021).

14. As per claim 6, O'Hara discloses the method wherein the second device includes a wireless access point which communicates with the first device (abstract, paragraph 0030).

15. As per claim 7, O'Hara discloses the method wherein the first device includes an alerting arrangement notifying the user when to enter the PIN code (paragraph, 0012, 0025).

16. As per claim 8, O'Hara discloses the method wherein the alerting arrangement includes at least one of a speaker emitting a predetermined sound and a set of LEDs emitting a predetermined lighting pattern (paragraphs, 0013).

17. As per claim 9, O'Hara discloses the method wherein the obtaining step includes the following substeps: limiting a time period for the user to enter the PIN code to a predetermined time period, and refusing to accept the PIN code from the user when the predetermined time period has expired (paragraphs, 0015-0016).

18. As per claim 10, O'Hara discloses the method wherein the pairing process includes the following substeps: compiling a providing first sample data, from a collection of random data, by the second device, the second device then providing the first sample data to the first device (paragraph, 0010-0012, 0024), generating second data, by the first device, a function of the first sample data, the PIN code and a hashing procedure; providing at least a portion of the second data by the first device to the second device (paragraphs, 0010-0012, 0021), generating third data by the second

device as a function of at least one of the authorized PIN codes stored in the database, the second data received from the first device and the hashing procedure; comparing, by the second device, the second data received from the first device to the corresponding third data and when the second data received from the first device matches to the third data, generating an indication the pairing process is successfully completed (paragraphs 0010, 0019).

19. As per claim 11, O'Hara does not disclose the method wherein the link key is one of a temporary key which is effective only for a single session and a long-term key which is effective for multiple sessions between the first and second devices. However, Laing discloses wherein the link key is one of a temporary key which is effective only for a single session and a long-term key which is effective for multiple sessions between the first and second devices (abstract, col. 1, lines 50-67).

The same motivation that was utilized in the combination of claim 1 applies equally as well to claim 11.

20. As per claim 12, O'Hara discloses the method wherein the step of: establishing a secure communication between the first and second devices using a predetermined encryption technology (paragraphs 0010, 0019).

21. As per claim 13, O'Hara discloses a system comprising: a first wireless mobile device including only a data capturing arrangement ("DCA") as an input device interface with a user thereof; and a second device receiving an initial signal from the first device to establish a wireless communication, the second device initiating an authentication

process (paragraph, 0010-0012, 0024), wherein the first device obtains a PIN code from the user via the DCA, the PIN code identifying at least one device with which the first device is authorized to communicate (paragraphs, 0010-0012, 0021), wherein the first and second devices perform a pairing process to compare the PIN code to entries in a database of authorized PIN codes (paragraphs 0010, 0019). He does not expressly disclose generating a link key to establish the authenticated communication between the first and second devices. However, in the same field of endeavor, Laing discloses generating a link key to establish the authenticated communication between the first and second devices (abstract, col. 1, lines 50-67).

The same motivation that was utilized in the combination of claim 1 applies equally as well to claim 13.

22. As per claim 14, O'Hara discloses the system wherein the second device includes a memory arrangement storing the database (paragraphs 0010, 0019).

23. As per claim 15, O'Hara discloses the system wherein the first device is a mobile barcode scanner (abstract, paragraph 0030).

24. As per claim 16, O'Hara discloses the system wherein the first device communicates with the second device using Bluetooth technology (paragraphs, 0029-0030).

25. As per claim 17, O'Hara discloses the system wherein the first device scans a barcode using the DCA, the barcode being provided by the user as the PIN code, a

processor of the first device converting the barcode into the PIN code (paragraphs, 0010-0012, 0021).

26. As per claim 18, O'Hara discloses the system wherein the second device includes a wireless access point which communicates with the first device (abstract, paragraph 0030).

27. As per claim 19, O'Hara discloses the system wherein the first device includes an alerting arrangement notifying the user to enter the PIN code (paragraph, 0012, 0025).

28. As per claim 20, O'Hara discloses the system wherein the alerting arrangement includes at least one of a speaker emitting a predetermined sound and a set of LEDs emitting a light in a predetermined lighting patterns (paragraphs, 0013).

29. As per claim 21, O'Hara discloses the system wherein the pairing process includes the following substeps: compiling a first sample data, from a collection of random data, by the second device, the second device then providing the first sample data to the first device (paragraph, 0010-0012, 0024), generating second data, by the first device, as a function of the first sample data, the PIN code and a hashing procedure; providing at least a portion of the second data by the first device to the second device, generating third data by the second device as a function of at least one of the authorized PIN codes stored in the database, the second data received from the first device and the hashing procedure (paragraphs, 0010-0012, 0021); comparing, by the second device, the second data received from the first device to the corresponding third data and when the second data received from the first device matches to the third

data, generating an indication the pairing process is successfully completed (paragraphs 0010, 0019).

30. As per claim 22, O'Hara does not disclose the system wherein the link key is one of a temporary key which is effective only for a single session and a long-term key which is effective for multiple sessions between the first and second devices. However, in the same field of endeavor, Laing discloses the system wherein the link key is one of a temporary key which is effective only for a single session and a long-term key which is effective for multiple sessions between the first and second devices (abstract, col. 1, lines 50-67).

The same motivation that was utilized in the combination of claim 1 applies equally as well to claim 22.

31. As per claim 23, O'Hara discloses the system wherein the first and second devices establish a secure communication using a predetermined encryption technology (paragraphs 0010, 0019).

32. As per claim 24, O'Hara discloses a wireless mobile device comprising: a processor; a wireless communication arrangement; and a data capturing arrangement ("DCA") being the only input device interface for a user thereof (paragraph, 0010-0012, 0024), wherein the processor generates a request for establishing an authenticated wireless communication, the request being forwarded to the further device via the communication arrangement, the communication arrangement receives from the further device a first sample data, compiled from a collection of random data, and a request for

second data, the DCA obtaining a PIN code from the user, the PIN code identifying at least one device with which the mobile device is authorized to communicate, the processor generating the second data as a function of the PIN code, the first sample data and the hashing procedure, the second data being provided, by the mobile device, to the further device (paragraphs, 0010-0012, 0021), wherein the further device generates third data as a function of at least one of the authorized PIN codes stored in a database, the second data received from the mobile device and the hashing procedure, (paragraphs 0010, 0019). He does not expressly disclose generating a link key to establish the authenticated communication between the first and second devices. However, in the same field of endeavor, Laing discloses generating a link key to establish the authenticated communication between the first and second devices (abstract, col. 1, lines 50-67).

The same motivation that was utilized in the combination of claim 1 applies equally as well to claim 24.

33. As per claim 25, O'Hara discloses the mobile device wherein the mobile device is a mobile barcode scanner (paragraphs 0010, 0019).

34. As per claim 26, O'Hara discloses the mobile device wherein the mobile device communicates with the further device using Bluetooth technology (abstract, paragraph 0030).

35. As per claim 27, O'Hara discloses the mobile device wherein the DCA scans a barcode which is provided by the user as the PIN code, the processor converting the barcode into the PIN code (paragraphs, 0029-0030).

36. As per claim 28, O'Hara discloses the mobile device wherein an alerting arrangement notifying the user to enter the PIN code (paragraphs, 0010-0012, 0021).

37. As per claim 29, O'Hara discloses the mobile device wherein the alerting arrangement includes at least one of a speaker emitting a predetermined sound and a set of LEDs emitting a predetermined lighting pattern (abstract, paragraph 0030).

(10) Response to Argument

The Appellant has indicated that the first device includes "only" a data capturing arrangement (DCA) as an input device which does not disclose by O'Hara's invention. Claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977)." Something Which Is Old Does Not Become Patentable Upon The Discovery Of A New Property, MPEP § 2112. The issue is whether the argument has persuasively rebutted the examiner's *prima facie* case of obviousness. The argument does not rebut the *prima facie* case. The claim is directed to a device includes only a data capturing arrangement as input. O'Hara's device teaches each and every element of the first device including the data capturing arrangement as input. In addition, O'Hara's device has some other input peripheral such as keyboard. It is obvious for an ordinary skill in the art would have recognized that the

first device could have only the DCA as input. There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference.

Schering Corp. v. Geneva Pharm. Inc., 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003). There is nothing different between the data capturing device of the claimed application and that of O'Hara's patent. Under those circumstances, examiner correctly stipulated that O'Hara's device which has Biometric verification scanner; *i.e.*, the ability to capture data, would be an inherent property of the disclosed data capturing device. Whether or not O'Hara's device has more than one input is not defeating. Even if the application had discovered only one input it would still not render the claim patentable because the prior art has each and every element of the claimed device. In addition it has some additional input peripheral. *In re Best, supra* . Here all the product elements are the same and examiner made out a proper *prima facie* case of obviousness. Therefore, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342,1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999).

Applicant also argues that O'Hara fail to teach the PIN limitation which is obtained by the DCA. Examiner respectfully disagrees. The simple meaning of PIN is "Personal Identification Number" according to the specification of the present application. O'Hara, actually disclose that the device he uses in his invention captures the PIN number and other indicia including identity of the user (See O'Hara, abstract). Any ordinary person

skill in art will agree that the capturing the personal identification number by a data capturing device and capturing the fingerprint or identity or other indicia as O'Hara's invention teaches are disclosing the same feature of the invention.

(11) Related Proceedings Appendix

No decision rendered by a court of the Board is identified by the examiner in the Related Appeals and Interferences section of the examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Mohammad W Reza/

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